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OLIFF & BERRIDGE, PLC.  
P.O. BOX 320850  
ALEXANDRIA, VA 22320-4850

EXAMINER
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* RONALD D. HOUSE, DAVID A. ECK, ALAN J. NEWTON,  
LANNY D. SMITH, STEVEN L. WHISTLER, TRUNG T. NGUYEN,  
JAMES C. BIEBER, DONALD B. AYLER, and GORDON W. JIM

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Appeal 2009-007157  
Application 10/630,863<sup>1</sup>  
Technology Center 2600

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Before JOHN C. MARTIN, MARC S. HOFF,  
and CARLA M. KRIVAK, *Administrative Patent Judges*.

HOFF, *Administrative Patent Judge*.

DECISION ON APPEAL<sup>2</sup>

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<sup>1</sup> The real party in interest is Xerox.

<sup>2</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

## STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from a Final Rejection of claims 5, 6, 8-10, 12, and 15. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Appellants' invention relates to a digital image forming device and method that enables data from sheet media to be digitized using an image forming device and stores this digital data on a portable digital storage media or any external electronic media. The digital image forming device performs this service at cost to a user through a payment interface. Additionally, the user may purchase paper and blank electronic media (i.e., CD-ROMs, DVD-ROMs, and floppy disks) at the digital image forming device. Furthermore, the digital data may be transferred from any storage media controlled by a portable digital device, such as a digital camera, a cell phone, a portable computer, or a PDA. Moreover, the digital data may be transferred from a remote storage device accessible through an external network, such as the Internet (Abstract; Spec. [0008] and [0030-32]).

Claim 5 is exemplary:

5. A method of purchasing a portable digital storage media from a digital image forming device, comprising:
  - purchase determining whether to purchase blank media, the purchase determining comprising selecting a portable digital storage media type;
  - media transfer determining whether to transfer image data between physical media,
  - the media transfer determining comprising transferring the image data from external media to internal media through a memory;
  - network transfer determining whether to transfer the image data from a network,
  - the network transfer determining comprising determining a remote target and downloading the image data from a network to the internal media through the memory;

upload transfer determining whether to upload the image data to a network,  
the upload transfer determining comprising determining a remote target and uploading the image data from external media to the network;  
transferring a computer image file from a network storage;  
dispensing the portable digital storage media;  
and selecting a remote target and transferring the computer image file from the network storage to the portable digital storage media before the step of dispensing the portable digital storage media at the remote target.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Roe	US 5,988,431	Nov. 23, 1999
Wasilewski	US 2002/0105665 A1	Aug. 8, 2002

Claims 5, 6, 8-10, 12, and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wasilewski in view of Roe.

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the Appeal Brief (filed November 20, 2008), the Reply Brief (filed January 1, 2009), and the Examiner's Answer (mailed December 23, 2008) for their respective details.

## ISSUE

Appellants contend Wasilewski and Roe fail to disclose all of the positively recited features since the disclosed method of Wasilewski requires that a user or customer make “the decisions (determinations) as prompted on the touch screen user interface” (App. Br. 12). Appellants assert that modifying Wasilewski to enable a user to purchase blank portable digital storage media at a kiosk would impermissibly modify the principle operation of Wasilewski since one would not purchase blank media from an ATM

(App. Br. 15-16). Appellants argue that distribution of blank, unmarked, media from a financial institution may cause a breach in security which is a cause for concern since Wasilewski discloses many different means for authenticating the transaction process (App. Br. 16). Appellants contend that the Examiner in his Office Action has “ignored” the “mandate” of MPEP § 2143 which “is that ‘[t]he key to supporting any rejection under 35 U.S.C. §103 is the clear articulation of the reasons why the claimed invention would have been obvious’” (App. Br. 17). Finally, Appellants assert that the Examiner has presented no objective evidence of record to support a method of integrating photographic imaging and non-imaging products and services using an automatic teller machine (App. Br. 18).

Appellants’ contentions present us with the following issue:

Would the skilled artisan have been motivated to combine the references to include distribution of blank disks as disclosed by Roe in the digital image kiosk disclosed by Wasilewski?

#### FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

##### *Invention*

1. The digital image forming device or kiosk 100 includes a digital media section 120 that enables a user to operate the digital image forming device. Digital media section 120 includes a keyboard 150 and/or any other appropriate data input device (Spec. ¶ [0031]).

##### *Wasilewski*

2. Wasilewski discloses “a combined kiosk for photographic image producing image goods and/or service kiosks and non-imaging

products and/or services such as an Automatic Teller Machine (ATM) kiosk” (§ [0001]).

3. Wasilewski discloses that when a customer desires to request an image product and/or service 200, the customer initiates a request on kiosk 100, following the prompts on the touch screen user interface 102. An image may be retrieved from a remote location through the network connection 118, imaging camera 101, image scanner 106, or from a file stored on media such as a CD, memory card/stick, or disk using the peripheral options available on a computer 112. The customer is enabled to make image edits or enhancements (step 206) and to select a particular image product/service (step 208). The customer pays for the transaction prior to rendering the photographic image using a credit card or a multi-card reader 116 (step 214). In step 218, the kiosk dispenses the requested image product or service once the payment method has been approved. Kiosk 100 may dispense small or large size image prints. In the alternative, kiosk 100 may dispense images stored on electronic media such as CD, memory card/stick, and disk using the computer 112 peripherals. (Figs. 3 and 5; §§ [0058] and [0060]).

*Roe*

4. Roe discloses a vending machine system for vending computer storage media, wherein a user selects a disk to be purchased from the vending machine (Abstract; col. 2, ll. 42-61).

PRINCIPLE OF LAW

On the issue of obviousness, the Supreme Court has stated that “the obviousness analysis cannot be confined by a formalistic conception of the

words teaching, suggestion, and motivation.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 419 (2007). Further, the Court stated “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* at 416.

## ANALYSIS

### *Rejection of claims 5, 6, 8-10, 12, and 15 under 35 U.S.C. § 103(a)*

We select claim 5 as representative of this group of claims, pursuant to our authority under 37 C.F.R. § 41.37(c)(1)(vii).

Representative claim 5 recites “purchase determining whether to purchase blank media.” Independent claims 8 and 12 recite a claim limitation similar in scope.

We do not consider Appellants’ arguments to be persuasive to show Examiner error. Specifically, we do not agree with Appellants’ contention that modifying Wasilewski to enable a user to purchase blank portable digital storage media at the kiosk would impermissibly modify the principle of operation of Wasilewski (App. Br. 15-16). Wasilewski’s stated purpose is to combine a kiosk for photographic image products and services with a kiosk for non-imaging products and services (FF 2). Thus, adding the feature of dispensing blank electronic media, as taught by Roe, would not impermissibly modify the principle operation of Wasilewski.

Concerning Appellants’ contention of lack of motivation to combine the references, we agree with the Examiner’s conclusion that it would have been obvious to a person of ordinary skill in the art to modify the teachings of Wasilewski to incorporate the sale of a blank portable media storage devices, as taught by Roe, for the purpose of providing the user with the

option to purchase blank storage media from a kiosk instead of a retailer (Ans. 6; App. 17-18). Generally, Wasilewski relates to a kiosk that combines an ATM with a photographic image producing kiosk (FF 2). Particularly, Wasilewski discloses that kiosk 100 dispenses an image product or service such as small and large prints, photo IDs or photo images stored on CD, memory card/stick, and disk using peripheral options available on a computer (FF 3). Roe discloses a vending machine system that dispenses computer storage media (FF 4). Since Wasilewski provides distribution of electronic media having photographic images stored on the media, improving Wasilewski by adding distribution of blank electronic media is a predictable use of prior art elements according to established functions. *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 416, 417 (2007).

We find that Appellants' additional argument that Wasilewski is directed to a kiosk that requires user or customer interaction is not commensurate with the scope of the claims (App. Br. 13). We agree with the Examiner that it "is clearly implied in Applicants' disclosure and in the claims that in order for the system and method to work, some sort of input from a user is necessary" (Ans. 11; FF 1).

Therefore, we find that the Examiner has established a prima facie case of obviousness because the combination of Wasilewski and Roe discloses a method of purchasing a portable digital storage media from a digital image forming device that includes the option of purchasing blank media. As a result, we will sustain the Examiner's § 103 rejection of representative claim 5, independent claims 8 and 12, and that of dependent claims 6, 8-10, and 15.

### CONCLUSION

The skilled artisan would have been motivated to combine the references to include the distribution of blank disks as disclosed by Roe in the digital image kiosk disclosed by Wasilewski.

### ORDER

The Examiner's rejection of claims 5, 6, 8-10, 12, and 15 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

Appeal 2009-007157  
Application 10/630,863

AFFIRMED

ELD

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